

a number of claims that are considered allowable and create no requirement for such language. The following examples from the PTO Guidelines found independent claim 1 wanting, but found claims 2 and 3 that depend from claim 1 acceptable. These acceptable claims contain none of the recitations demanded by the Examiner.

Example: Mutual Fund

Claim 1

A computerized method of allocating funds for a mutual fund among a plurality of funds in a group, comprising the steps of:

- a. receiving at least one fund identifier for each of said plurality of funds;
- b. receiving at least one risk ranking factor for each of said plurality of funds;
- c. receiving at least one set of allocation parameters which correspond to the desired allocation of funds relative to a profile of said ranking factors;
- d. storing the fund identifiers, the risk ranking factors and the allocation parameters on a computer readable medium;
- e. receiving an initial investment value which is to be invested in the funds;
- f. receiving an incremental investment allotment value and
a period for the incremental investment allotment value;
- g. receiving an indication of allowable level of investor risk; and

h. using the stored fund identifiers, the risk ranking factors and the allocation parameters in combination with the initial investment value, the incremental investment allotment value, the period for the incremental investment allotment value, and d the indication of allowable level of investor risk to provide an optimum account allocation between the funds in the group.

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Table Notes for Claim 1

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6. The failure of the claim to positively include a data allocation step to allocate the data in the optimum way, i.e., the practical application of the mathematical algorithm, is the reason why the requisite functionality (to achieve the practical application) has not been realized. See Guidelines, Section IV.B.2(c) and (d). The claim should be rejected under 35 U.S.C. § 101.

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Example: Mutual Fund

Claim 2

The method of claim 1, further including the step of displaying the optimum account allocation on an investor monthly account summary report to an investor or broker.

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Table Notes for Claim 2

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Note 4: Claimed invention is limited to the practical application of preparing and displaying the summary report to an investor or broker. A summary report has real world value and provides immediate benefit. Claimed invention is also limited to the practical application of displaying the optimal account allocation to the investor. The specification

discloses three embodiments, two of which "advise" the investor of possible investment strategies. The investment strategies are based on the calculated optimal account allocation. Thus, given its broadest reasonable interpretation in light of the specification, displaying the optimal account allocation to the investor is more than the mere output of the calculation because the display must be provided in a format which "advises" the investor of possible investment strategies, i.e., have real world value and immediate benefit. See Guidelines, Section IV.2(d)(iii).

Claim 3

The method of claim 1, further including the step of transferring funds between the mutual funds in the group according to the optimum account allocation.

In addition, many claims in issued patents have been considered adequate without such language. Thus, it is respectfully requested that the Examiner withdraw his requirement therefor.

Reconsideration is respectfully requested of the rejection of claim 33 under 37 USC 112. The Examiner alleges that the specification does not support the language "on the basis of amounts in prior transactions by the consumer at the merchant". Applicant cannot agree. Page 4, first paragraph states that the merchant agrees to pay the NC rebates based upon the shopping activities of the SC.

Reconsideration is respectfully requested of the rejection of claims 1 to 46 under 37 USC 103 over Hovakimian patent 5,466,919 in view of the article "Flowers as a

Double Gift” published in the New York Times on May 5, 1990. The Examiner also mentions promotions by retailers and merchants but only speculates on their operation.

The claims are believed to be distinct and non-obvious from all of the references alone or in combination for the reasons recognized by the Examiner in his admission that Hovakimian fails to suggest certain features. It is submitted that the remaining references add nothing to Hovakimian to make the claims obvious. None of the references, alone or in combination suggests the claimed subject matter or in any manner makes the claims obvious.

The Examiner admits that Hovakimian does not disclose the steps of:

“Providing by the merchant, not the card issuer, the rebates, as determined by the merchant or product vendor, to the donor or the purchaser, wherein the calculated rebates are to be deducted by the merchant from the donor's purchase and paid by the merchant to selected charitable organizations.

“Maintaining a schedule of rebates, as determined by one or more merchants due to one or more charities.”

The Examiner alleges that in the article, "Flowers as a Double Gift", a purchaser buying flowers at a Petal Power P05 can earn a ten percent (10%) rebate that is

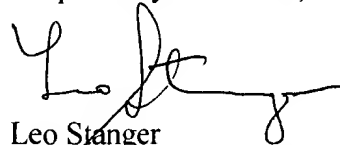
deducted from the purchaser's bill and wherein the 10% rebate is donated to a charity selected by the purchaser or suggested by a Petal Power representative who maintains a charity list having more than one hundred non-profit organizations. Finally, the purchaser's donated 10% rebate is tax deductible.

However the article adds nothing to Hovakimian to make the claims obvious. In the Flowers article it is still not the merchant that provides the rebates. In the flowers article a portion of the purchaser's payment is rebated to the non-profit and the buyer receives the tax deduction. That is not what is claimed.

The Examiner also speculates on retailers that offer promotions. However, such speculation is inadequate to reach a conclusion of obviousness. The Examiner's simply alleges obviousness on the specious proposition that all systems provide gratification to the consumer and the non-profit and are therefore interchangeable. Obviousness is determined by what the art suggests not what conjecture offers.

In view of the above it is respectfully requested that the claims be allowed and the case passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Leo Stanger', written over a horizontal line.

Leo Stanger
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